REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 14, 2005. In the Office Action, claims 1-15 and 17-21 were rejected under 35 U.S.C. §103. Applicants respectfully traverse these rejections in their entirety. Claims 13 and 19 have been amended. Claims 22 and 23 have been added. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

First Rejection Under 35 U.S.C. § 103

Claims 13-15 and 18-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Waldin (U.S. Patent No. 6,094,731) in view of Menezes (a publication entitled "Handbook of Applied Cryptography"). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations.

For instance, with respect to claims 13 and 19, Applicants respectfully submit that neither Waldin nor Menezes, alone or in combination, describes or even suggests determining whether a digital signature accompanies a file to be accessed. *See page 3 of the Office Action.* In contrast with the statement in the Office Action that Waldin (col. 7, lines 22-28) provide such teachings, Applicants respectfully submit that column 7, lines 22-28 of Waldin is directed to an operation where a file returns from a remote location and is check to see whether it is virus free.

> Recipient computer 11 could be the same as originating computer 2. For example, originating computer 2 might want to send file 1 to a remote location for backup purposes and, when file 1 was brought back to the original location,

originating computer 2 would want to check to see whether file 1 is virus free. In this case, computer 2 acts as both the originator and the recipient. Waldin at col. 7, lines 22-28.

Hence, based on this lack of teaching of a limitation common to claims 13 and 19, these claims are allowable and the outstanding §103(a) rejection should be withdrawn.

In addition, with respect to claim 13, Applicants respectfully submit that neither Waldin nor Menezes, alone or in combination, in particular column 6, lines 18-65 of Waldin, describes or suggests (1) entering into an isolated execution mode if the file does not have a corresponding digital signature chain (as discussed above); (2) analyzing an integrity of the file during the isolated execution mode; and (3) issuing the digital signature chain if the file has an acceptable file integrity during the isolated execution mode. In contrast, Waldin (col. 6, lines 18-65) merely describes comparison on the size, date and version number of the files for rescanning determination and subsequent hash comparisons of specific scanned sectors. These operations are not pertinent to the isolated execution mode as claimed.

Moreover, with respect to claim 19, neither Waldin nor Menezes, alone or in combination, suggest code for issuing the digital signature chain if the file has an acceptable file integrity, the code for issuing the digital signature chain being stored in protected memory *and accessible only when the processing unit is operating in the isolated execution mode*. Emphasis added.

Based on the fact that neither Waldin nor Menezes, alone or in combination, suggest each and every limitation set forth in claims 13 and 19, Applicants respectfully request withdrawal of the §103(a) rejection as applied to claims 13 and 19 as well as those claims dependent thereon.

Second Rejection Under 35 U.S.C. § 103

Claims 1-5 and 9-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Waldin in view of Menezes and Garney (U.S. Patent No. 5,386,552). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. However, Applicant notes that claim 1 has been amended to include the limitation that the signature generator is adapted to produce a digital signature chain including a digital signature having the scanning result *and a version number of the file analyzer. Emphasis added.*

Hence, Applicants respectfully request the Examiner to reconsider the allowability of claim 1 and claims 2-5 and 9-12 dependent thereon, taking into account that in certain cases, that the discovery of the source of a problem may result in a patentable invention despite any alleged contention that the solution was obvious. *See In re Sponnoble, 405 F.2d. 578, 160 USPQ 237 (CCPA 1969).*

Third Rejection Under 35 U.S.C. § 103

Claims 6-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Waldin in view of Menezes, Garney and Swaney (U.S. Patent No. 4,488,232). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. However, these claims are dependent on claim 1, and thus, are allowable if the corresponding independent claim 1 is held allowable. Hence, the withdrawal of the §103(a) as applied to claims 6-8 is requested.

Fourth Rejection Under 35 U.S.C. § 103

Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Waldin in view of Menezes and HP (EP 1030237). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Herein, claim 17 includes the limitation of issuing *the digital signature chain with an indication that the file integrity is unacceptable* if the integrity of the file is analyzed and determined to be unacceptable. *Emphasis added.* In contrast, HP teaches a Boolean value stored within memory to indicate a lack of integrity of the platform, but does not teach or suggest the digital signature chain with such features as claimed.

Hence, the withdrawal of the §103(a) as applied to claim 17 is requested requested.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: 06/14/2005

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